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PATENT APPLICATION  
09/589,038

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	Li Mo et al.
Serial No.:	09/589,038
Filing Date:	June 6, 2000
Group Art Unit:	2616
Confirmation No.	9665
Examiner:	Chuong T. Ho
Title:	Method and System for Providing a Protection Path for Connectionless Signals in a Telecommunications Network

**Mail Stop: AF**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Dear Sir:

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

The following Pre-Appeal Brief Request for Review ("Request") is being filed in accordance with the provisions set forth in the Official Gazette Notice of July 12, 2005 ("OG Notice"). Pursuant to the OG Notice, this Request is being filed concurrently with a Notice of Appeal. The Applicants respectfully request reconsideration of the Application in light of the remarks set forth below.

**REMARKS**

For the reasons discussed below, Applicants contend that the rejection of Claims 1, 5-10, 19 and 22-29 contain clear legal and factual deficiencies. Therefore, Applicants request a finding that these rejections are improper and allowance of these claims.

In a Final Office Action dated March 29, 2006, the Examiner rejected Claims 1, 5-7, and 19 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,711,125 issued to Walrand et al. ("*Walrand*") in view of U.S. Patent No. 6,226,111 issued to Chang et al. ("*Chang*").

A *prima facie* case of obviousness cannot be maintained at least because (even assuming for the sake of argument that the references did suggest or motivate a combination of the references to a person of ordinary skill in the art at the time of the invention) *Walrand* and *Chang*, whether considered singly, in combination with one another, or in combination with information generally available to those of ordinary skill in the art at the time of the invention, fail to disclose all of the elements of the pending claims.

For example, Claim 1 recites "generating a first protection path . . . ; generating a second protection path . . . , the second protection path distinct from the first protection path such that the first and second protection paths do not have any common nodes or links." The Examiner asserts that these limitations are disclosed in *Walrand* by protection paths p1 (708) and p2 (712). However, *Walrand* specifically discloses and illustrates that path 708 runs from node Z1 to node S (see Col. 9, lines 2-5; Fig. 7) and that path 712 runs in the opposite direction between node Z3 and node S (see Col. 9, lines 5-7; Fig. 7). Therefore, referring to Figure 7 of *Walrand*, paths 708 and 712 have nodes Z1, Z2, and Z3 (as well as the links between these nodes) in common. Thus, *Walrand* cannot teach or suggest the above-quoted limitation. The Examiner does not address these arguments (which were made in Applicants' previous Response) in the Final Office Action. Instead, the Examiner simply provides the same basis for rejection as in his previous Office Action (the Examiner's argument on this issue can be found on pages 2 and 4 of the Final Office Action).

In addition, Claim 1 recites that “generating the first protection path and generating the second protection path each comprise *decomposing* the telecommunications network *into a ring and at least one ear*.” As the Examiner points out in the Final Office Action, *Walrand* does not disclose these limitations. The Examiner asserts that these limitations are disclosed in *Chang* -- citing Figure 12, Column 13, lines 65-67, and Column 14, lines 1-15. This is the same assertion that the Examiner previously made with respect to *Chang*, which Applicants have refuted in at least their last two Responses (filed September 26, 2005 and March 7, 2006). However, the Examiner again does not address Applicants’ arguments and simply restates the same assertions.

As Applicants previously have shown, neither Figure 12 nor the cited passages nor any other portion of *Chang* discloses that generating a first protection path and generating a second protection path each comprise decomposing the telecommunications network into a ring and at least one ear, as required by Claim 1. The cited passages and figure refer to two different four-fiber bidirectional APS self-healing rings (90.1 and 90.2) interconnected by a cross-connect 92. They do not refer to a telecommunications network being decomposed into a ring and at least one ear. As an example only, Applicants direct the panel’s attention to the discussion of network decomposition in the present Application with reference to FIGURES 2 and 3 on pages 9-12 of the “Detailed Description of the Invention.” For at least this additional reason, Claim 1 is allowable.

Furthermore, Claim 19 contains limitations similar to those discussed above with reference to Claim 1. Therefore, for the reasons provided above, Applicants respectfully request reconsideration and allowance of Claims 1 and 19, as well as the claims that depend from these independent claims.

In addition to depending from an allowable independent claim, several of the dependent claims also include additional limitations not found in the cited references. For example, and without limitation, Claim 5 recites “charting the ring horizontally beginning with the destination node and ending with the destination node.” For a teaching of this limitation, the Examiner simply refers to *Chang*, Column 13, lines 65-67 and Column 14, 1-15. Again, the Examiner previously asserted this portion of *Chang* as a teaching of this limitation, and Applicants refuted this assertion in their previous Responses. However, the Examiner again has not addressed

Applicants' arguments in the Final Office Action. Applicants respectfully fail to see how this cited passage is a teaching of the recited limitation. The cited material refers to Figure 12, which makes no disclosure or suggestion of charting the ring horizontally beginning with the destination node and ending with the destination node. Again, by way of example and without limitation, Applicants direct the panel's attention to the discussion of network decomposition and charting in the present Application with reference to FIGURE 3 on pages 11-12 of the "Detailed Description of the Invention." For at least this additional reason, Claim 5 is allowable. Since Claims 6 and 7 share this limitation, Claims 6 and 7 are allowable for at least this additional reason. Furthermore, Claims 6 and 7 include further limitations not addressed by the Examiner.

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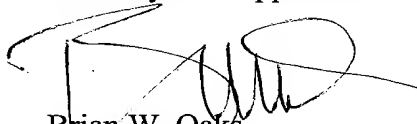
The Examiner also rejects Claims 8-10 under 35 U.S.C. § 103(a) as being unpatentable over the combined system of *Walrand* and *Chang* in view of U.S. Patent No. 5,949,755 issued to Uphadya et al. ("*Uphadya*"). In addition, the Examiner rejects Claims 22-24 and 26-29 under 35 U.S.C. § 103(a) as being unpatentable over the combined system of *Walrand* and *Chang* in view of *Uphadya*. Claims 8-10, 22-24 and 26-29 depend from one of independent Claims 1 and 19 and are thus allowable at least because they include the limitations of either Claim 1 or 19, which have been shown to be in condition for allowance. For at least this reason, Applicants respectfully request reconsideration and allowance of Claims 8-10, 22-24 and 26-29.

**CONCLUSION**

As the rejection of Claims 1, 5-10, 19 and 22-29 contains clear deficiencies, Applicants respectfully request a finding of allowance of Claims 1, 5-10, 19 and 22-29. If the PTO deems that an interview is appropriate, Applicants would appreciate the opportunity for such an interview. To the extent necessary, the Commissioner is hereby authorized to charge any required fees or credit any overpayments to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.  
Attorneys for Applicants

A handwritten signature in black ink, appearing to read 'Brian W. Oaks', is written over the printed name and registration number.

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Date: MAY 2, 2006

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